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CASE PI/5-20691/A/PCT

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Kim Wright — Type or print name

Kim Wright — Signature

7/21/02 — Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#25

IN RE PCT NATIONAL STAGE APPLICATION OF
O'SULLIVAN ET AL.
INTERNATIONAL APPLICATION NO: PCT/EP96/05564
FILED: 12 DECEMBER 1996
U.S. APPLICATION NO: 09/091,333
35 USC §371 DATE: 26 OCTOBER 1998
FOR: PROCESS FOR THE PREPARATION OF 2-CHLORO-5-CHLOROMETHYL-THIAZOLE

Art Unit: 1613
Examiner: R. Gerstl

OFFICE OF PETITIONS
Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION UNDER 37 CFR 1.181

Sir:

This is a petition under Rule 181 from the Examiner's decision not to set up an interference between the present application and U.S. patent 5,679,796. This petition is submitted within two months of the mailing date of action from which relief is requested.

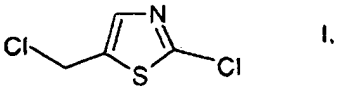
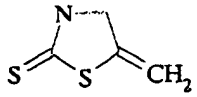
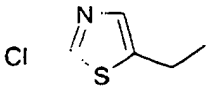
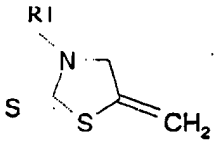
I. STATEMENT OF THE MATERIAL FACTS IN SUPPORT OF THE PETITION

1. The present application 09/091,333 is a § 371 of international application no. PCT/EP96/05564 filed December 12, 1996 having a § 119(a) priority date of December 21, 1995 based on Swiss application no. 3636/95. The § 371 requirements of the above-identified application were met on October 26, 1998.

2. The cited U.S. patent 5,679,796 was granted on October 21, 1997.

3. The filing date of the present application with respect to 35 U.S.C. § 135(b) is the international filing date of December 12, 1996 (37 CFR § 1.495); well before the grant date of the '796 patent.

4. Original claim 2 of the instant application is direct d to substantially the same invention (37 CFR 1.601 (n) as claim 1 of the '796 patent:

Applicants Original Claim 2	Claim 1 of 5,679,796
. A process for preparing a compound of the formula  I, which comprises reacting a compound of the formula  (II) In free form or in salt form, with a chlorinating agent.	. Process for the preparation of 2-chloro-5-chloromethylthiazole of the formula (I)  (I) characterized in that 5-methylene-1,3-thiazolidine-2-thione of the formula (II)  (II) in which R1 represents hydrogen or the group R2-CO-, in which R2 represents alkyl or optionally substituted phenyl, are reacted with a chlorinating agent, optionally in the presence of a diluent.

5. The following summarizes the actions that have taken place in the prosecution of this application:
   (a) Restriction Requirement (Note: Office Action Summary page indicates shortened 1 month response period)
   (b) Applicants responded to restriction requirement (5/18/99)
   (c) Office Action (6/28/99) – Examiner rejected claims as not being made prior to one year from date on which U.S. 5,679,796 was granted.
   (d) Applications Request Reconsideration (9/27/99) for the following reasons:

- The PTO has neglected to carry is burden for establishing a prima facie case as to why 35 U.S.C. § 135 should operate in the instant case to effect a statutory bar, estoppel or loss of right.
- Applicants' claims in question were made prior to one year from the date on which US Patent 5,679,796 was granted.

(e) Final Rejection (11/05/99) – Examiner stated that Applicants are not entitled to an earlier date of PCT and Swiss applications because Applicants failed to comply with 37 C.F.R. 1.495(b).

(f) Notice of Appeal (5/5/00)

(g) Appeal Brief Filed (8/10/00) The final rejection raised a single issue: Are Claims 1 – 7, 9, 12 and 13 Unpatentable Under 35 USC §135(b) as Not Being Made Prior to One Year From the Date on Which U.S. Patent No. 5,679,796 was Granted?

(h) Office Action (mailed 9/22/00) – Withdrawing Finality of Action with a 3 months shortened statutory period for response. The Examiner suggested an allowable claim for purposes of copying with a 30 day time period, but failed to indicate this time period on the Office action cover sheet.

(i) Response (2/22/01) – Applicants did not copy claim since, as noted above, claim 2 directed to "substantially the same invention" was present in the application as originally filed.

(j) Office Action (mailed 5/18/01) – Examiner states that Applicants failure to present claims amounts to a disclaimer of subject matter.

(k) In an amendment filed November 19, 2001 Applicants requested the Examiner to set up an interference between this application and the '796 patent as soon as possible.

(l) In the Office action mailed December 21, 2001 the Examiner made his rejection of the instant application final and invited Applicants' to file the instant petition.

II. STATEMENT OF THE PRECISE RELIEF REQUESTED

1. Applicants request the declaration of an interference between the present application and U.S. patent 5,679,796 pursuant to 37 CFR 1.607.

   In compliance with the requirements of 37 C.F.R. 1.607, the following points are noted"

   (a) The patent with which interference is requested is U.S. Patent No. 5,679,796.

   (b) The Count that Applicants propose for the interference is newly added Claim 69, added by the November 19, 2001 amendment.

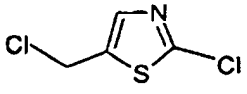
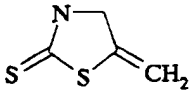
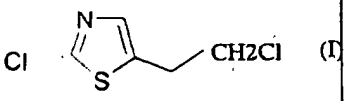
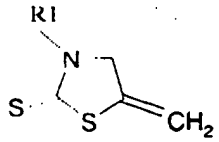
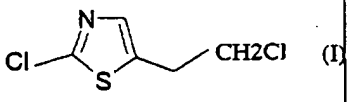
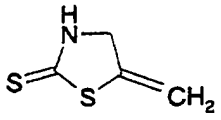
   (c) Claim 1 of Kraatz '796 corresponds to the proposed Count.

(d) Claims 2-7, 9, 10, 12-14 and 69 correspond to the proposed Count. These claims, while not identical to the proposed Count, are deemed to define the substantially the same invention as the proposed Count.

(e) The requirements of 35 U.S.C. § 135(b) are met in view of the fact that claims 2-7, 9, 10 and 12-14 wer presented less than one year from the October 21, 1997 issue dat of Kraatz '796. Moreover, claims directed to substantially the same subject matter were presented almost a year prior to the issue date of the Kraatz '796 patent

III. REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED

Applicants have amended the application to recite a claim as suggested by the Examiner for purposes of proposing a count in the interference. However, Applicants believe this claim to have alr ady been in the application as filed. The table below compares Claim 2, as originally filed, to Claim 1 of the patent and the suggested count (corresponding to the claim for copying)

Applicants Original Claim 2	Claim 1 of 5,679,796	Suggested Claim for Copying
. A process for preparing a compound of the formula  I, which comprises reacting a compound of the formula  (II) in free form or in salt form, with a chlorinating agent.	. Process for the preparation of 2-chloro-5-chloromethylthiazole of the formula (I)  characterized in that 5-methylene-1,3-thiazolidine-2-thione of the formula (II)  (II) in which R1 represents hydrogen or the group R2-CO-, in which R2 represents alkyl or optionally substituted phenyl, are reacted with a chlorinating agent, optionally in the presence of a	. Process for the preparation of 2-chloro-5-chloromethylthiazole of the formula (I)  characterized in that 5-methylene-1,3-thiazolidine-2-thione of the formula (II)  II, is reacted with a chlorinating agent, optionally in the presence of a diluent.

	diluent.	

It is clear from the above comparison that Applicants original claim 2 is dir cted to "substantially the same invention" as the issued patent, U.S. 5,679,796. This has been pointed out to the Examiner in sev ral communications.

37 CFR 1.605 (a) states:

> If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner may suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent.

In the present case, Applicant's submit that 37 C.F.R. 1.605(a) does not apply since there is a claim already present in the application drawn to the same patentable invention. Further, it was not required that the Examiner present a claim in the case where there is a claim present in the application drawn to substantially the same patentable invention. In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (CCPA 1958). Again, from the above chart, it is clear that all of the material limitations of the patent claim are present in original claim 2. Although Applicants believe that the application as originally filed contains a claim to substantially the same patentable invention, the amendment presented on November 19, 2001 was made for purposes of providing a proposed count for the interference.

In Paper No. 18 (mailed 9/22/00), the "Office Action Summary" states that the period for r sponse is set to expire "3 months" from the mailing date of the communication. Based on this, the docketing clerk set the period to expire on 12/22/00 with normal extension periods available under 37 CFR 1.136(a) until 3/22/01. Applicants responded to the Office Action on February 22, 2001.

However, buried in the Office Action on the last page was a "One Month or Thirty Day" time period without extensions available. Applicants submit that this hidden shortened statutory period for response should not cause Applicants to lose their claimed invention. Applicants have processes in place such that the docketing clerk reads the Office Action Summary page and inputs this date as the date a response is due. Applicants should not be penalized for a "hidden" shortened statutory response date which was on the last page of the Office Action.

Further, by reviewing the prosecution history of this case it is clear that the Examiner has conceded that Applicants had presented a claim within one year of the grant date of the patent as

required under 35 U.S.C. § 135(b). Applicants' Appeal Brief presented persuasive arguments as to why 35 U.S.C. § 135(b) was not applicable since Applicants had presented claims prior to one year from the date on which U.S. '796 had been granted. Based on the Appeal Brief, the Examiner withdrew the finality of the rejection, thereby admitting th pr s nt application contains claims to "substantially the same subject matter" as at least on of th claims of the patent; and that the claims were presented within the required one year time period. Both of these conditions were met prior to the expiration of the one-year period after grant of the patent.

IV. CONCLUSION

In view of the foregoing, it is clear that the instant petition under Rule 181 is timely filed. An early and favorable consideration of this is respectfully requested.

It is believed that no fee is required for filing this petition. However, if any fee under 37 CFR § 1.17 is due in connection with this communication, the Assistant Commissioner is authorized to charge Deposit Account No. 50-1676 for the appropriate amount.

Respectfully submitted,

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